

Docket No.: 1362002-2005.2
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Chris Lee et al.

Application No.: 10/814,972 Confirmation No.: 8626

Filed: March 30, 2004 Art Unit: 3737

For: GUIDEWIRE AND CONNECTOR THEREFOR Examiner: P. Luong

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Status of Claims

Claims 1-17, 20, 22, 24, 25, 27, 28, 31, 32, 34-36, 38, 45, 46, and 49-52 are currently pending. A copy of the pending claims accompanies this document.

§ 112 Rejections - Clear Errors in the Rejections

Claims 1-17, 20, 22, 24-25, 27-28, 31, 32, 34-36, 38, 45, 46, and 49-52 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. There are clear errors in the rejections of these claims and the Applicants traverse these rejections.

The Application at issue includes two independent claims: claim 1; and claim 25. During prosecution, claims 1 and 25 were each amended to recite an inner conductor and an outer conductor contact having equal diameters. The Final Office Action, mailed October 1, 2010, asserts that “[t]he specification as originally filed fails to disclose 1) wherein the inner conductor contact [h]as a diameter equal to the diameter of the outer conductor contact” (Final Office Action, page 2).

The Final Office Action asserts that the specification, however, only discloses the inner conductor being “approximately the same diameter” as the outer conductor (Final Office Action, pages 2-3).

During prosecution, claims 49 and 50 were added. Claims 49 and 50 each recite an outer conductor having an equal diameter to each of the inner conductor contact and the outer conductor contact. The Final Office Action asserts that “[t]he specification as originally filed fails to disclose ... 2) wherein the diameter of the outer conductor contact is equal in length to the diameter of each of the inner conductor contact and outer conductor contact” (Final Office Action, page 2). The Final Office Action asserts that the specification, instead, only discloses “relatively the same diameter” (Final Office Action, page 3).

As indicated by M.P.E.P. § 2163.06, “information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.”

Figure 1 of the instant application is provided below.

FIG. 1

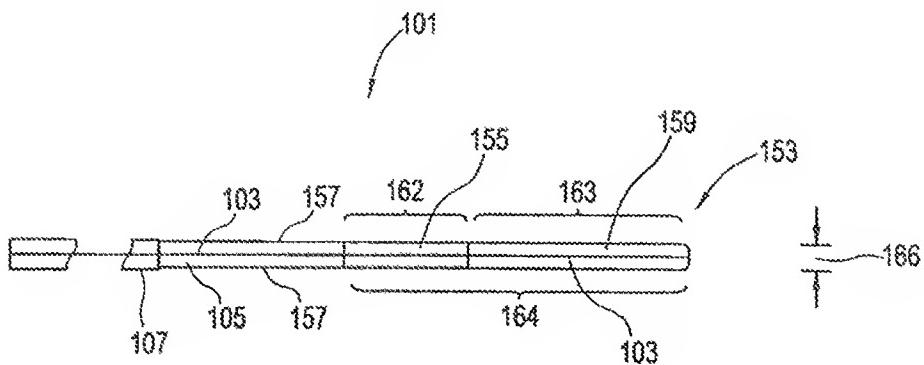


Figure 1 of the instant application shows a proximal end of a guidewire. The proximal end of the guidewire 101 includes an outer conductor (157) and an extended section (164) that includes an inner conductor contact (163) and an insulated area (162) disposed between the outer conductor

(157) and the inner conductor contact (163) (see e.g., paragraph [0040] of the instant application). Figure 1 additionally shows that the outer conductor (157) extends beyond the proximal end of the outer insulation (107) to expose conductive areas for electrical contact (see e.g., paragraph [0040]). Thus, the exposed conductive area of the outer conductor labeled “157” is the outer conductor contact.

Figure 1 clearly shows the inner conductor contact and the outer conductor contact having equal diameters, as recited in claims 1 and 25. Additionally, Figure 1 clearly shows the outer conductor as having an equal diameter to each of the inner conductor contact and the outer conductor contact, as recited in claims 49 and 50.

Thus, the recitations in claims 1 and 25 of an inner conductor and an outer conductor contact having equal diameters, and the recitations in claims 49 and 50 an outer conductor having an equal diameter to each of the inner conductor contact and the outer conductor contact are contained in the drawings of the application at issue. Therefore, as indicated by M.P.E.P. § 2163.06, since the recitations at issue are contained in the drawings, the recitations may be added to claims 1, 45, 49, and 50 without introducing new matter.

Moreover, M.P.E.P. § 2163(I) states that, “[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” M.P.E.P. § 2163(I) additionally states that “[a]n applicant shows possession of the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.”

Thus, the standard for satisfying the written description requirement is whether the patent specification describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.

Paragraph [0040] of the instant specification states that “the inner conductor (103) may be built up ... to approximately the same diameter (166) as the outer conductor (157)” (emphasis added). Additionally, paragraph [0043] of the instant specification provides direct support for “a pair of contacts that are exposed to the connector in a sequential axial configuration, both of which are relatively the same diameter as the outer conductor” (emphasis added).

One skilled in the art would reasonably conclude that the inventor had possession of the claimed invention. One of skill in the art would consider the recitations of the contacts and the outer conductor having equal diameters to be encompassed by the terms “approximately the same diameter” and “relatively the same diameter”, as stated in paragraphs [0040] and [0043], respectively. Moreover, as discussed above, the relevant figure (Figure 1) shows the conductor contacts and the outer conductor having equal diameters. Given that the specification states that the diameters of the contacts and outer conductor have “approximately” and “relatively” the same diameter, and that the relevant figure shows the elements as being equal, barring a definitive statement to the contrary, one of skill in the art of forming guidewires would assume that the recitation of “equal diameter” is encompassed by the terms “approximately the same diameter” and “relatively the same diameter”.

Thus, there is adequate support in the specification for the recitations in claims 1 and 25 of an inner conductor and an outer conductor contact having equal diameters, and the recitations in claims 49 and 50 of an outer conductor having an equal diameter to each of the inner conductor contact and the outer conductor contact.

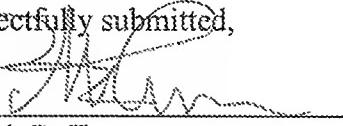
Therefore, as indicated by M.P.E.P. § 2163.06, since the recitations at issue are contained in the specification, and as also indicated by M.P.E.P. § 2163(I), since the specification describes the recitations at issue in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the recitations, the recitations may be added to claims 1, 45, 49, and 50 without introducing new matter.

Accordingly, for at least this additional reason, the rejections of claims 1, 25, 49, and 50, as well as the rejections of claims 2-17, 20, 22, 24, 27, 28, 31, 32, 34-36, 38, 45, 46, 51, and 52, which depend from claims 1 and 25, should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If the Examiner has any questions or concerns, the Applicants encourage the Examiner to contact the Applicants' representative, Patrick Turner, by telephone to discuss the matter.

Dated: December 30, 2010

Respectfully submitted,

By 
Patrick R. Turner

Registration No.: 49,050
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, New York 10151
(206) 336-5683
(212) 588-0500 (Fax)
Attorneys/Agents For Applicant